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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/903,465	07/11/2001	Kirk Steven Tecu	10016935-1	9335

7590 01/26/2005  
HEWLETT-PACKARD COMPANY  
Intellectual Property Administration  
P.O. Box 272400  
Fort Collins, CO 80527-2400

EXAMINER

SAFAIPOUR, HOUSHANG

ART UNIT PAPER NUMBER

2622

DATE MAILED: 01/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/903,465

Applicant(s)

TECU ET AL.

Examiner

Houshang Safaipoor

Art Unit

2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 8-12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7, 13, 14, 17-19 is/are rejected.
- 7) ☒ Claim(s) 15 and 16 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

## DETAILED ACTION

### *Election/Restrictions*

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-7 and 13-19, drawn to template matching, classified in class 382, subclass 209.
- II. Claims 8-12, drawn to reflective and transparent scanning, classified in class 358, subclass 474.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed. The subcombination has separate utility such as scanning.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with James Baudino (Reg. # 43,486) on 1/24/05 a provisional election was made without traverse to prosecute the invention of group I, claims 1-7 and 13-19. Affirmation of this election must be made by applicant in replying to this Office action. Claims 8-12 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 5-7, 13, 14, 17-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Chang (Patent Application Publication No. 2002/0039205).

Regarding claim 1, Chang discloses a template for a scanner system, the template comprising: a template body, and an element for generating an optical pattern when scanned in the scanner system (fig. 1, page 2 [0026]).

Regarding claim 2, Chang discloses the template according to claim 1, wherein the template further comprises an insert area for receiving a transparent media therein (fig. 1).

Regarding claim 3, Chang discloses the template according to claim 1, wherein the element is a pattern printed on the template body (Mark 122, page 2 [0026]).

Regarding claim 5, arguments analogous to those presented for claim 3 are applicable to claim 5.

Regarding claim 6, Chang discloses the template according to claim 1, wherein the optical pattern is comparable to one or more reference patterns stored in a computer (page 2, [0026]).

Regarding claim 7, Chang discloses the template according to claim 6, wherein the computer directs the scanner system to execute a scan routine upon determining a match between the optical pattern and one of the reference patterns (page 2, [0026]).

Regarding claim 13, Chang discloses a scanner system for optically scanning a media, the scanner system comprising: a reflective scanner comprising a platen, a lamp, an optic system and one or more photosensitive devices; a transparent media adapter comprising a housing and operable to backlight a transparent media; and a template comprising an element for generating an optical pattern when scanned in the scanner system (figs. 1 & 2, page 2, [0024]).

Regarding claim 14, Chang discloses the scanner system according to claim 13, wherein the scanner system is coupled to a computer, the computer storing one or more reference patterns each associated with a scan routine, the scanner system performing a reflective scan over a predefined distance of carriage translation and transmitting imaged data obtained by the reflective scan to the computer, the computer operable to compare the imaged data with the reference patterns (page 2, [0026]).

Regarding claims 17 and 18, arguments analogous to those presented for claims 3 and 5 are applicable to claims 17 and 18 respectively.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chang (Patent Application Publication No. 2002/0039205).

Chang does not disclose expressly a tab connected to an edge of the template body.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to connect the tab to the edge of the template. Applicant has not disclosed that the tab provides an advantage, is used for a particular purpose or solves a stated problem. Therefore, it would have been obvious to one of ordinary skill in this art to modify Chang's apparatus to obtain the invention as specified in claims 4 and 19.

#### ***Allowable Subject Matter***

Claims 15 and 16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Houshang Safaipoor whose telephone number is (703)306-4037. The examiner can normally be reached on Mon.-Thurs. from 6:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L Coles, Sr. can be reached on (703)305-4712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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Patent Examiner  
Art Unit 2622  
January 24, 2005

Regarding claim 6, Chang discloses the template according to claim 1, wherein the optical pattern is comparable to one or more reference patterns stored in a computer (page 2, [0026]).

Regarding claim 7, Chang discloses the template according to claim 6, wherein the computer directs the scanner system to execute a scan routine upon determining a match between the optical pattern and one of the reference patterns (page 2, [0026]).

Regarding claim 13, Chang discloses a scanner system for optically scanning a media, the scanner system comprising: a reflective scanner comprising a platen, a lamp, an optic system and one or more photosensitive devices; a transparent media adapter comprising a housing and operable to backlight a transparent media; and a template comprising an element for generating an optical pattern when scanned in the scanner system (figs. 1 & 2, page 2, [0024]).

Regarding claim 14, Chang discloses the scanner system according to claim 13, wherein the scanner system is coupled to a computer, the computer storing one or more reference patterns each associated with a scan routine, the scanner system performing a reflective scan over a predefined distance of carriage translation and transmitting imaged data obtained by the reflective scan to the computer, the computer operable to compare the imaged data with the reference patterns (page 2, [0026]).

Regarding claims 17 and 18, arguments analogous to those presented for claims 3 and 5 are applicable to claims 17 and 18 respectively.

Regarding claims 4 and 19 Chang does not explicitly provide a tab connected to an edge of the template body, however, it would have been obvious matter of design choice to modify Chang's teaching to connect a tab to Chang's apparatus for generating an optical pattern.



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***Allowable Subject Matter***


Claims 15 and 16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Houshang Safaipoor whose telephone number is (703)306-4037. The examiner can normally be reached on Mon.-Thurs. from 6:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L Coles, Sr. can be reached on (703)305-4712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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January 24, 2005

  
JOSEPH R. POKRZYWA  
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